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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,660	03/21/2001	James D. Causey III	PD-0448 CON	3658

23608 7590 10/20/2004

MEDTRONIC MINIMED INC.
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EXAMINER

THOMPSON, MICHAEL M

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/813,660

Applicant(s)

CAUSEY ET AL.

Examiner

Michael M. Thompson

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 9-41 is/are pending in the application.
- 4a) Of the above claim(s) 17-31 and 41 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5, 6, 10, 11, 15 and 33 is/are allowed.
- 6) ☒ Claim(s) 1-4, 9, 12-14, 16, 32 and 34-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/9/04, 8/12/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892 or PTO-1449, they have not been considered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 7-9, 12-14, 16, 32, and 34-40 rejected under 35 U.S.C. 102(b) as being anticipated by Franetzki et al. (4,270,532). Franetzki et al. teaches an external infusion device (I., II., III.) for infusing fluid comprising a housing, a reservoir in the housing, a drive system, at least one power supply, one or more electrical elements coupled to the power supply that regulate the rate of the drive system, and a tab (I. or II., or both collectively) that mates with the housing containing at least one electrical element. He teaches the tab as being replaceable and may be changed with different tabs (column 7), the tab further having a power supply (Figure 3),

Art Unit: 3763

insertable into an opening in the housing or attachable to the exterior, removable, and is disposable. In each case the tab is clearly connected to the housing and is disposable if one so chooses. It is conceivable that a user may take the tab portion of the construction of Franetzki et al. and utilize it with other models that have been produced therefore being interchangeable between several "different" infusion devices. (Claim 13) Consequently, the fact that these devices are only usable together means they can only be used in a predetermined number of external infusion devices. (Claim 14) The tab may affect whether or not a fluid path is opened since the fluid distribution is programmably controlled by the tab. The tab may further include at least a portion of the drive system such as the battery power,

Allowable Subject Matter

4. Claims 5-6, 10-11, 15, and 33 are allowed.

Response to Arguments

Applicant's arguments filed 07-15-2004 have been fully considered but they are not persuasive. It is the Examiner's position that the rejection of record was broad enough to envision two separate perspectives. In one perspective the tab may only include programming device I. and the housing would collectively include the control device II. and microdosing unit III. thereby satisfying the limitations of the claims. From another perspective it may be considered that while the tab may consist collectively of programming device I. and control device II. and the connection between the control device II. and microdosing unit III. at reference numbers (12 and 14) as being the insertable portion of the tab within the microdosing housing. In conclusion, it is

Art Unit: 3763

understood that Applicant has fully responded to all rejections and raised all errors with respect to the Examiner's rejection. Since there is no further traversal beyond the above-mentioned issues it appears that Applicant has acquiesced to all other rejections of record and therefore the instant Office Action has been made Final.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3763

Contacts

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Michael Thompson whose telephone number is (703) 305-1619. The Examiner can normally be reached on Monday through Friday from 9 am to 5 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Nick Lucchesi, can be reached on (703) 308-2698. The official fax phone number for all submissions to the organization where this application or proceeding is assigned is (703) 872-9306.

Michael M. Thompson

Patent Examiner



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MT



October 15, 2004